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**In The
Supreme Court of the United States
October Term, 1989**

FEIST PUBLICATIONS, INC.,
Petitioner,

v.

RURAL TELEPHONE SERVICE COMPANY, INC.,
Respondent.

**BRIEF OF AMICUS CURIAE HAINES AND
COMPANY, INC., IN SUPPORT OF PETITIONER
FEIST PUBLICATIONS, INC.**

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THE INTEREST OF AMICUS CURIAE

This brief of *amicus curiae* Haines and Company, Inc. ("Haines") is being filed with the written consent of the parties. The parties' letters of consent are being filed concurrently with the Clerk of this Court.

The interest of Haines in the instant case arises from the fact that Haines filed a petition for a writ of certiorari (No. 90-731) on November 2, 1990, to review the judgment of the Court of Appeals for the Seventh Circuit in *Illinois Bell Telephone Company v. Haines and Company, Inc.*, 905 F.2d 1081 (7th Cir. 1990), holding Haines liable for copyright infringement for using alphabetical telephone directories as a source for information in creating its cross reference directories. The issues presented in the *Feist* and *Haines* petitions overlap to the extent that they both involve the question of whether the copyright in a telephone directory extends only to the selection, arrangement and

coordination used to express the facts contained therein. Haines' petition, however, raises this question in a broader context because it involves noncompeting directories and also raises the additional question of whether the absence of substantial similarity in expression between an alphabetical telephone directory and a cross reference directory precludes a finding of copyright infringement. The different facts and additional issues presented in Haines' petition may be of assistance to this Court in deciding the basic issue of what constitutes infringement of the copyright in a telephone directory.

A cross reference directory is a street address directory which is primarily used to discover information concerning street addresses in an area. (905 F.2d at 1084)¹ Sample segments of Haines' directory are reproduced below:

THE HAINES DIRECTORY

LILLIAN CT 60042 ISLAND LAKE

103	NISSEN C E	526-2343	9
105	SOMME ROBT A	526-6305	8
	SOMME ROBT A CHLD	526-9025	8
106	TUCKER WM	526-2492	3
107	GRANUM ERNEST H	526-5865	9
111	XXXX	00	
	* 0 BUS	6 RES	0 NEW

LILLIAN PL W 60002 ANTIOCH

22520	TURNER O W	395-1254	3
	* 0 BUS	1 RES	0 NEW

LILY W 60050 MC HENRY LILYMOOR AREA

701	COFFMAN RANDALL	385-1112	0
702	NETTLES CHAS E	385-5005	7
704	XXXX	00	
	* 0 BUS	3 RES	0 NEW

LILY LN 60021 FOX RIVER GRV

503	HOVORKA CLARENCE C	639-5370	+4
505	RODERICK ROBT J	639-8055	+4
	* 0 BUS	2 RES	2 NEW

LIMERICK DR 60013 CONT

2810	WEICHER MATHEW L	639-7143	6
2811	BIRCH LOUIS G	639-0306	+4
2812	MEYER WM A	639-1975	+4
2813	LALOND ALLEN	639-4459	
2814	IVERSON BARBARA	639-5835	9
2815	LALOND ALEX A	639-2898	1
2816	MOORE TERENCE	639-8128	3
2817	IGOE RUSSELL	639-1809	0
2818	XXXX	00	
2819	MCHAMARA PATK	639-8121	3
2820	XXXX	00	
2822	WILSON D	639-4189	
	* 1 BUS	21 RES	3 NEW

LINCOLN 60102 ALGONQUIN

308	XXXX	00	
309	CARDELLA P	658-9453	+4
	PAWLUSKI STANLEY	658-7508	
310	XXXX	00	
315	MARRAH THOS W	658-6876	
	MARRAH THOS W	658-6876	7
321	TRIPLETT WM J JR	658-4191	0
326	GREBENS CHAS B	658-4387	8
327	MAY GLENN H	658-6108	8
333	HINKLE JAS M	658-4662	0
401	JUDO ROBT C	658-7102	5
403	BEU MARIAN J	658-7442	+4
407	JANSEN CHAS R	658-2310	0
414	OAKES EVERETTE	658-8244	
420	BOHSE M	658-8807	7
426	ANDERSON NELS E	658-7128	2
427	PETTERSON H	658-4186	5
433	KASPER C	658-3821	2

THE HAINES DIRECTORY

1035	BRIDGEMAN HILL JENNIFER	225 OLIVER AV WOOD
1036	BRIDGEMAN HILL CH	226 COUNTY R WOOD
1040	BRIDGEMAN HILL CH	1001 WILSON WOOD
1051	ODEN J D JR	1115 RIDGELAND AV WOOD
	ODEN J D JR	1115 RIDGELAND AV WOOD
1053	RETHORIANE CH GRD	631 MC ALISTER AV W
1060	TOP O THE BORN	439 FRANKLIN WOOD
1075	BUTTERNUT BREAD BV	3000 GRAND AV WAO
1080	WATERHEAD BANDER BN	712 GENESEE S WAO
1087	MC DONALD RESTAUNT	2249 BELVUE RD W
1087	REYES GROCERY STR	29 GENESEE S WAINES

(815)338-0010

0040	ROUSEY GLENN	220 DONOVAN AV E WOODST
0041	MART DONALD C	525 CALHOUN E WOODSTOCK
0042	PABOS S M	342 VINE WOODSTOCK
0044	HEER M C	322 SEMINARY AV N WOODS
0047	WALSH JAS M	918 BLAKELY WOODSTOCK
0048	JARNECKE NORMAN L	1721 SEMINARY AV N W
0049	LEHMAN LARRY	476 JACKSON W WOODSTOCK
0050	HEUCHLER S B MD	844 OAK WOODSTOCK
0051	STYLAN H JOE ATTY	111 DEAN WOODSTOCK
0052	CAPLAN MICHAEL S	1308 ISLAND CT WOODSTO
0053	WOODSTOCK NEWS AGCY	542 WASHINGTON
0054	TAYLOR GEO B	1217 BLAKELY WOODSTOCK
0055	WEDERMAN EDNA A	888 SOUTH E WOODSTOCK
0056	THOMAS HENRI	315 MADISON W WOODSTOCK
0057	DEBORAH ARTHUR MD	4101 DEAN STREET RD W
0059	COMOR WM M	1440 DODWOOD LN WOODST
0059	THORNE H K	708 DEAN WOODSTOCK
0060	GLUTH FRANK	2202 STENG WOODSTOCK
0062	PULLERTON ROBT G	1312 OAKVIEW TER WOOD
0065	NICHOLS LUCILLE	111 TERRY CT WOODSTOCK

0181	STANGER EMMA MRS	312 TAPPAN WOODSTOCK
0182	ANDREW RUSSELL F	13201 HICKORY LN WOOD
0184	SHWEL RAYMOND C REV	1912 HICKORY RD W
0185	SCHNEIDERMAN LEROY	174 TERRY CT WOODS
0186	JOHNSON RAYMOND MRS	515 AED W WOODS
0187	FEDERAL LAND BANK	2002 SEMINARY AV N W
0188	MATHES CTY LAMES	189 CHURCH WOODSTOCK
0189	MCBROOK F L	351 MADISON S WOODSTOCK
0190	DONAHUE JOHN J	18509 COUNTRY CLUB RD W
0191	PHILIPP JACOB	420 LAUNDALE AV WOODSTO
0192	LEE JIM W	12901 PLEASANT AVE RD WOC
	NORTHMAN H ALARM CO	12901 PLEASANT AVE
0194	VANDEVEER MICHAEL	8412 CONCORD DR WOOD
0195	NELSON RUSSELL V	731 WHEELER WOODSTOCK
0196	BAYTON ROBT E	1250 MITCHELL WOODSTOCK
0197	BONE FRANKLIN S	1213 CLAY WOODSTOCK
0198	JOHNSON RONALD A	1427 SEMINARY AV N W
0199	LUMPP EDW T	14518 PLEASANT RD WOODSTOCK
0200	WHEATON WM L	611 W HALL AV W WOODST
0202	SWITTS BOBBY SHOP	225 CALHOUN E WOODS
0203	CANNIZZARO E	115 DONOVAN AV E WOODST
0204	WILSON WM C	631 JEFFERSON S WOODSTO
0207	LISTER DON J	525 PLEASANT WOODSTOCK
0210	WOODSTOCK OPTICAL BV	884 JACKSON W WOOD
0211	SCALLY E J	10612 COUNTRY CLUB RD WOOD
0212	ANDERSON GLENN E	418 PLEASANT WOODSTO
0213	PORT DONALD	3104 RAYCRAFT RD WOODSTO
0214	PHILLIPS BRADLEY	331 HAYWARD S WOODSTO
0215	KRUMPER MILTON	482 JACKSON W WOODSTOCK
0216	HELMER ROGER	542 PLEASANT WOODSTOCK
	HELMER ROGER SERV	542 PLEASANT WOODS
0217	VANDEVEER L	8412 CONCORD DR WOODSTOCK
0218	LUSH GEO E	406 PLEASANT RD W WOODST
0221	BAKER PETERSON CO	6000 VAN AV W WOOD
0222	SCHWARTZ FRANK	130 WASHINGTON WOODSTO

In creating its cross reference directories, Haines uses telephone directories along with other publications, such as United States Postal Service and Census Bureau compilations and maps, solely as sources for facts. Haines independently creates its own selection, arrangement, and organization of the facts it compiles from these various sources. *See Illinois Bell Telephone Company v. Haines and Company, Inc.*, 683 F. Supp. 1204, 1206 (N.D. Ill. 1988).

Illinois Bell Telephone Company ("IBT") brought suit against Haines in 1985, alleging Haines infringed the copyrights in thirty-four different IBT alphabetical telephone directories published in 1982 and 1983 by using them as sources for facts for Haines' five Chicago area cross reference directories.

¹ Haines has published cross reference directories since 1932, and the independent cross reference directory publishing industry has been in existence since 1917. Its members publish over 600 directories serving virtually every community with over 20,000 households and businesses.

(683 F. Supp. at 1206-1207) Reproduced below is a sample segment of an IBT telephone directory:

KACZYNSKI B—KAI	ILLINOIS BELL	676
Kaczynski Boguslaw 5126 Wagoner Av — 283-4338	Kadai Stanley 815841 Wagoner Av — 334-4229	
Kaczynski Bruno J 3518 S Park Av — 984-9846	Kadane Arthur 2588 W Thorne Av — 989-6775	
Kaczynski Casimir 13010 S Houghton Av — 646-3491	Kadane David H 5819 W Race Av — 261-5128	
Kaczynski David KCPA 30 S Wacker Av — 387-8888	Kadane J 1827 W Wagoner — 361-1153	
Kaczynski Fella S 4843 W 43rd — 588-9421	Kadane Joseph A 2838 Wagoner Av — 777-3938	
Kaczynski Frank 3835 Wagoner Av — 945-3507	Kadane Aldro 1918 Wagoner — 477-6884	
Kaczynski Kathleen R 3316 W Calumet — 267-8843	Kadane C 6322 H Troy — 743-4886	
Kadajski Joanne 3145 Wagoner Av — 583-3167	Kadane Clarence 3732 Wagoner Av — 325-4783	
Kadala Suresh 6204 N Wagoner — 274-9736	Kadane E L 1908 Wagoner Av — 465-1815	
Kadala Anandh 6204 N Wagoner — 465-1712	Kadane Esther 429 Wagoner — 929-5696	
Kadala Min R 4917 N St Louis Av — 463-2283	Kadane Joan 5262 Wagoner Av — 734-2927	
Kadala Rajesh 4826 N Wagoner Av — 588-2704	Kadane Joe 448 Wagoner Av — 929-8889	
Kadala Ulrich 6548 N Wagoner Av — 338-8574	Kadane L C 3181 Wagoner Av — 761-8444	
Kadala Stephen J 2443 N Calumet Av — 342-3176	Kadane Michael 14937 Wagoner Av — 545-3788	
Kadala Nathan Mary — 4621 Wagoner Av — 478-9918	Kadane Robt G 5531 Wagoner Av — 774-3824	
Kaden Joseph 5815 S Wagoner — 476-4449	Kadane Paul 6171 N Wagoner Av — 262-2853	
Kadenoff Leo 5424 S Wagoner — 752-8887	Kadane Katherine 1934 N Clark — 337-4665	
Kadane Elizabeth 10 Wagoner — 642-6882	Kade 3508 Wagoner — 222-8629	
Kaden Dorothy V 4854 S Wagoner Av — 247-1986	Kade Chas B 18758 S State Line — 375-8344	
Kaden Frank R 5937 S Wagoner Av — 735-2541	Kadane Helen 5518 N Wagoner Av — 784-7353	
Kaden John A 5538 S Wagoner — 434-3549	Kadane Voltaire 5523 Wagoner Av — 275-9958	
Kaden Kenneth 8124 S Wagoner Av — 735-3417	Kader Harot 5528 N Wagoner — 388-9461	
Kaden Edgar 2880 N Lake St Dr — 949-8878	Kaden John J 3618 N Wagoner Av — 348-4923	
Kaden Elson 3508 Wagoner — 644-1763	Kadashin G 2908 Wagoner Av — 871-8687	
Kaden Harbert L 5645 S Wagoner Av — 752-5472	Kadashin D 4941 S Wagoner Av — 767-6238	
Kaden J 1238 N State — 943-3265	Kadashin Helen 1859 N Wagoner Av — 276-3781	
Kaden Rudolph E 5247 N Wagoner Av — 334-7987	Kadashin Josef 5885 Wagoner — 734-4384	
Kade D 4447 N Wagoner Av — 973-3174	Kadashinski Leonard M — 2528 Wagoner Av — 628-2758	

IBT admitted that Haines' directories are completely dissimilar to IBT's directories in selection, arrangement, and purpose, and that Haines did not copy any of the original elements of IBT's directories. (683 F. Supp. at 1210) IBT limited its claim of infringement to Haines' use of information from IBT's directories. (683 F. Supp. at 1207) The District Court for the Northern District of Illinois held Haines liable for copyright infringement, stating Seventh Circuit law "protects a plaintiff compiler's copyright for even those facts that the plaintiff gathered from the public domain." (683 F. Supp. at 1209)

The Seventh Circuit affirmed the District Court's holding that a copyright in an alphabetical telephone directory protects the facts in the directory apart from their expression. (905 F.2d at 1086) The Seventh Circuit specifically rejected the principle that only the taking of a compilation's selection, coordination and arrangement of facts is prohibited by the Copyright Act. (905 F.2d at 1085) The Court also rejected the contention that only the use of substantially similar expression constitutes infringing use under the copyright law. (905 F.2d at 1086)

The harmful consequences of the *Feist* decision are demonstrated by its application to the facts in the *Haines* case. Cross

reference directories are useful works which serve completely different purposes than telephone directories. They are, therefore, a type of work which the policy promoting the free flow of information encourages. Under the *Haines* decision, however, the production of such works will be enjoined, with the result that the public will be deprived of a work whose function cannot be fulfilled by a telephone directory.

SUMMARY OF ARGUMENT

The Copyright Act provides specific limits on the protection accorded copyrighted works. 17 U.S.C. §§ 102 (b), 103 (b). The Copyright Act also specifies those elements of a compilation of facts which are properly protected. 17 U.S.C. § 101. The limits on protection provided by the Copyright Act are mandated by both the Constitutional grant of authority to enact copyright laws to protect only the "writings" of "authors" and the First Amendment. By holding that any copying of facts appearing in a copyrighted telephone directory constitutes infringement, the courts in *Feist* and in *Haines* have expanded the law of copyright well beyond its Constitutionally and statutorily defined limits.²

The *Feist* and *Haines* decisions also abolished the test of infringement requiring substantial similarity in expression. By misapplying precedent, these Courts equated the admission of use of a copyrighted work as a source for facts with proof of infringement of protected expression. This distorts the nature of a copyright, which is limited to the protection of an author's original expression from unauthorized use.

ARGUMENT

I. THE COURTS IN *FEIST* AND *HAINES* IMPROPERLY APPLIED THE COPYRIGHT ACT

Copyright is a statutorily created privilege and not a common law right. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 660-61, 663 (1834). *Accord*, *White-Smith Music Co. v. Apollo Co.*, 209 U.S. 1, 15 (1907). As stated in *Sony Corp. of America v. Universal*

² *Haines* has never relied on the fair use defense, nor has it contested the copyrightability of telephone directories.

City Studios, Inc., 464 U.S. 417, 429 (1984), "As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly" granted by the copyright law. Thus, "the language of the statute provides the starting point." *Stewart v. Abend*, ____ U.S. ____, 110 S. Ct. 1750, 1770, 109 L. Ed. 2d 184, 213 (1990) (Stevens, J., dissenting). *Accord, Community for Creative Non-Violence v. Reid*, 490 U.S. ____, 109 S. Ct. 2166, 104 L. Ed. 2d 811 (1989).

Specific provisions of the Copyright Act and the Constitution prohibit the protection of facts in a work as opposed to the original expression in which they are used. Section 102 (a) of the Copyright Act, 17 U.S.C. § 102 (a), provides that copyright protection subsists only in "original works of authorship." This requirement of originality reflects the Constitutional grant of authority to Congress to enact copyright laws to protect only the "writings" of "authors." U.S. Constitution, art. I, § 8, cl. 8. Since facts do not originate with an author, they cannot be the subject matter of copyright. *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5th Cir. 1981); M. & D. Nimmer, 1 Nimmer on Copyright, § 2.03 [E], pp. 2-34.1 — 2-34.2 (1989).

Section 102 (b) of the Copyright Act specifically states that protection of a work does not extend to any "idea" or "discovery" appearing in the work "regardless of the form in which it is described, explained, illustrated, or embodied." The committee notes to this section confirm this dichotomy between facts and an author's expression:

Copyright does not preclude others from using ideas or information revealed by the author's work. It pertains to the literary, musical, graphic, or artistic form in which the author expressed intellectual concepts.

Report of the Committee on the Judiciary, H.R. Rep. No. 1476, 94th Cong., 2d Sess., p. 56 (1976).

This Court, in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 559 (1985), recognized that under § 102 (b), "No author may copyright his ideas or the facts he narrates." This Court further held that the First Amendment

necessitates the dichotomy between facts and their expression set forth in § 102 (b), stating (471 U.S. at 560):

The Second Circuit noted, correctly, that copyright's idea/expression dichotomy strikes a definitional balance between the First Amendment and the Copyright Act by permitting full communication of facts while still protecting an author's expression.

Compilations of facts may constitute proper subjects of copyright under 17 U.S.C. § 103 (a). Section 103 (b) limits the scope of protection of compilations, however, in accordance with § 102, to the material contributed by the author, as distinguished from the preexisting facts contained in the work. Section 101 of the Act specifically defines the originality in a compilation as the arrangement, coordination and selection displayed by the compilation as a whole:

A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

Thus, the only original material an author of a compilation of facts can possibly contribute is the selection, ordering and arrangement of facts. M. & D. Nimmer, 1 Nimmer on Copyright, § 2.04 [B], pp. 2-40 — 2-42; § 3.04, pp. 3-16 — 3-18 (1989); Patry, *Copyright in Collections of Facts: A Reply*, Communications and the Law 10, 16 & n.30 (October 1984). A prohibition against the use of facts apart from their expression in a compilation would violate Article I of the Constitution, Sections 102 and 103 of the Copyright Act and the First Amendment. By ignoring these statutory and Constitutional limitations, the courts in *Feist* and *Haines* have granted telephone companies an absolute monopoly over the information contained in their directories.

An extension of a telephone utility's monopoly to prohibit use of customer information violates the fundamental policy underlying the Copyright Act. This policy is to encourage the creation of works of intellect by protecting an author's expression, while at the same time permitting the public to benefit from

the progress resulting from further use of the ideas and information published in such works. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558, 563 (1985); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980). By eliminating the dichotomy between facts and expression, the decisions in *Feist* and *Haines* destroy the balance struck by the Copyright Act between the interests of authors and the public. If these decisions are allowed to stand, they will stifle the progress which the copyright law is designed to promote.

II. THE COURTS IN *FEIST* AND *HAINES* HAVE ELIMINATED THE REQUIREMENT OF APPROPRIATION OF EXPRESSION IN COMPILATION CASES

A. Copyright Infringement Requires Proof Of Substantial Similarity Of Expression

The decisions in both *Feist* and *Haines* discard the traditional test of copyright infringement requiring substantial similarity in expression.³ The rejection of this standard distorts the rights granted by the Copyright Act.

In determining whether the copyright in a work has been infringed, courts have long required a showing that 1) the defendant used or "copied from" plaintiff's copyrighted work and 2) the copying constituted an "improper appropriation" of plaintiff's protected expression. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).⁴

³ The District Court in *Feist* held because petitioner admitted copying facts from respondent's directory, "we need not resort to an analysis of whether there was a substantial similarity between the two directories." (Pet. at 11a) The District Court in *Haines* relied on this holding in rejecting consideration of whether any of the expression of IBT's directories was used. (683 F. Supp. at 1209, 1210) The Seventh Circuit adopted this reasoning. (905 F.2d at 1086)

⁴ Some courts follow a test, based on the requirements of copying and improper appropriation established in *Arnstein*, which requires 1) copying of ideas; and 2) copying of a substantially similar expression. See *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

Improper appropriation of expression requires a showing that the material copied is protected by the author's copyright and that the parties' works are substantially similar. *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975); W. Patry, *Latman's The Copyright Law* 196-197 (6th ed. 1986).

The preliminary requirement of use or "copying" merely "protects the defendant who has never consulted the plaintiff's work but whose work is, because of coincidence or artistic convention, substantially similar to the plaintiff's." P. Goldstein, 2 Copyright § 7.12, p. 7 (1989). Once a court has established that a copyrighted work has been used or "copied," it must then proceed to determine whether that use or "copying" amounts to an infringement. *Nash v. CBS, Inc.*, 899 F.2d 1537, 1539-40 (7th Cir. 1990). As recognized by this Court, "... 'use' is not the same thing as 'infringement,' ... use short of infringement is to be encouraged." *Teleprompter Corp. v. Columbia Broadcasting System, Inc.*, 415 U.S. 394, 398 n.2 (1974), quoting B. Kaplan, *An Unhurried View Of Copyright* 57 (1967).

The courts in *Haines* and *Feist* misapplied the test of copyright infringement by merging the factual question of whether the defendants in those cases used the plaintiffs' works, which both defendants admitted, with the ultimate question of whether such use constituted an unlawful appropriation of expression.⁵ *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207-08 (9th Cir. 1989); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907, 909 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975). The defendants' admissions of "copying from" the plaintiffs' works in *Haines* and *Feist* only relieved the courts from determining circumstantially whether the act of "copying from" those works occurred. If "copying from" the plaintiffs' works had been denied, then the courts would have had to determine whether such "copying" occurred by, *inter alia*, comparing the parties' works for similarities in unprotected elements, as well as in expression. W. Patry, *Latman's The Copyright Law* 193, 196-197

⁵ While the District Court in *Haines* stated that "copying must also be infringing," it erroneously analyzed this requirement as a "common law fair use defense," rather than in terms of improper appropriation of expression. (683 F. Supp. at 1210)

(6th ed. 1986). As stated in *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir.), cert. denied, 423 U.S. 863 (1975), however, "substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement." Accord, W. Patry, *Latman's The Copyright Law* 193 & n.18 (6th ed. 1986) (noting that courts use "substantial similarity" to describe "both that type of similarity used to establish indirect proof of copying and that necessary to establish a *prima facie* case of infringement").

In analyzing whether there is substantial similarity in expression, similarities relating to unprotected elements such as facts are entirely irrelevant. The trier of fact, therefore, must exclude such elements in its substantial similarity analysis. *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207 (9th Cir. 1989); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48-49, 51 (2d Cir.), cert. denied, 476 U.S. 1159 (1986). As stated in *Cooling Systems & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 493 (9th Cir. 1985):

What is important is . . . whether the very small amount of protectible expression in Cooling Systems' catalog is substantially similar to the equivalent portions of Stuart's catalog.

Accord, *Taft Television & Radio Co. v. King Broadcasting Co.*, 5 U.S.P.Q. 2d 1355, 1358 (9th Cir. 1987); *Nash v. CBS, Inc.*, 704 F. Supp. 823, 826 (N.D. Ill. 1989), aff'd, 899 F.2d 1537 (7th Cir. 1990).⁶ Thus, a plaintiff must show the defendant copied a substantially similar selection, coordination and arrangement to show the copyright in its compilation of facts has been infringed.

⁶ To determine whether the expression, rather than the ideas, of a fictional work has been appropriated, the trier of fact determines whether the "ordinary reasonable person" would find the parties' works are substantially similar. *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120-21 (8th Cir. 1987); *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977); *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966).

B. The Courts In *Feist* and *Haines* Misinterpreted Authority Requiring "Copying"

Both *Feist* and *Haines* eliminated the need to prove an allegedly infringing work is substantially similar to a copyrighted work by misinterpreting an explanation of the elements necessary for a copyright infringement claim set forth in M. & D. Nimmer, 3 Nimmer on Copyright § 13.01, p. 13-4 (1989). This explanation states two elements are necessary to state a copyright infringement claim: ownership of the copyright by plaintiff; and copying by the defendant.⁷ The *Feist* and *Haines* courts mistakenly equated "copying" of information with copying of protected expression. The Nimmer treatise, however, clearly states that mere use of information does not constitute infringement (§ 13.03[B][2][b], p. 13-56):

Because no copyright may exist in facts per se, the copyright in a book dealing with factual matters cannot be infringed by a work that copies such facts, but in a manner in which the particular verbal description of such facts is not copied.

Thus, the "copying" Nimmer refers to is the copying of a substantially similar expression (§ 13.03[A], p. 13-23):

just as copying is an essential element of infringement, so substantial similarity between the plaintiff's and defendant's works is an essential element of copying.⁸

The only possible admission of infringement under this analysis is an admission of copying the author's expression, which was absent from *Haines* and *Feist*.

⁷ In stating the "ownership plus copying" explanation, the Seventh Circuit in *Haines* cited *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 614 (7th Cir.), cert. denied, 459 U.S. 889 (1982), which had cited Nimmer as establishing this test. (905 F.2d at 1086) The *Feist* court cited *Wickham v. Knoxville International Energy Exposition, Inc.*, 739 F.2d 1094, 1097 (6th Cir. 1984), which also cited Nimmer in support of the "ownership plus copying" test. (Pet. at 8a-9a)

⁸ The Nimmer treatise further states that only the arrangement of a telephone directory, if it is original, may be protected under the copyright law. (§ 3.04, pp. 3-18 — 3-20.1)

The Seventh Circuit in *Haines* misapplied its own authority in affirming the District Court's finding that proof of appropriation of protected expression is not required for a finding of infringement. In *Haines*, the Seventh Circuit quoted the Nimmer explanation from *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 614 (7th Cir.), cert. denied, 459 U.S. 889 (1982). (905 F.2d at 1086) In *Atari*, however, the Court held infringing copying consists of "appropriation of only those elements of the work that are protected by copyright" and recognized improper appropriation of expression, in addition to "copying," is required (672 F.2d at 615):

Some courts have expressed the test of substantial similarity in two parts: (1) whether the defendant copied from the plaintiff's work and (2) whether the copying, if proven, went so far as to constitute an improper appropriation.

The Seventh Circuit subsequent to *Atari* established a similar four-part standard for a copyright infringement action, which requires ownership and originality of the work, plus "copying the work by the defendant and a substantial degree of similarity between the two works." (emphasis added) *Evans Newton, Inc. v. Chicago Systems Software*, 793 F.2d 889, 893 (7th Cir.), cert. denied, 479 U.S. 949 (1986); *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984).

The case cited in *Feist* as authority for the "ownership plus copying" test of infringement, *Wickham v. Knoxville International Energy Exposition, Inc.*, 739 F.2d 1094, 1097 (6th Cir. 1984) (Pet. at 8a-9a), also recognized that substantial similarity in expression is required to show infringing copying:

Thus, copying is an essential element of infringement and substantial similarity between the plaintiff's and defendant's works is an essential element of copying. (emphasis added)

Feist further cited *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980), which also contradicts its position. (Pet. at 11a) In *Durham*, the Second Circuit recognized the requirement that there exist substantial similarity of expression and granted

summary judgment for the defendant, noting "Where the similarity demonstrated pertains solely to noncopyrightable material, summary judgment is appropriate." (630 F.2d at 915, citing *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir.), cert. denied, 449 U.S. 841 (1980)).

Thus, in all of the precedent cited by both the *Haines* and *Feist* courts to reject proof of substantial similarity in expression as a requirement for a finding of copyright infringement, proof of substantial similarity in expression was held to be an element of a *prima facie* case of infringement.

III. THE COPYRIGHT ACT PROVIDES NARROW PROTECTION TO TELEPHONE DIRECTORIES

Because the copyright law promotes the dissemination of ideas and information, the scope of protection afforded a work narrows as original expression decreases. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 564 (1985); *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir.), cert. denied, 469 U.S. 1037 (1984). Works communicating facts and information are, therefore, entitled to less protection than more creative works. *Cooling Systems & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 492 (9th Cir. 1985).

As this Court held in *Harper & Row*, the "law generally recognizes a greater need to disseminate factual works than works of fantasy." (471 U.S. at 563) This Court recognized that less expressive factual works, such as directories, are entitled to correspondingly less protection in order to ensure that copyright does not impede the dissemination of published facts:

[E]ven within the field of fact works, there are gradations as to the relative proportion of fact and fancy. One may move from sparsely embellished maps and directories to elegantly written biography. The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case.

(471 U.S. at 563, quoting Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. Copyright Soc. 560, 563 (1982))

Virtually no independent creativity is involved in creating telephone directories. Publication of these directories is required by law, and the contents of the directory are largely dictated by statute as well. Despite the limited amount of authorship in IBT's telephone directories and IBT's admission that Haines used none of that authorship, the Seventh Circuit in *Haines* provided IBT's telephone directories with extraordinary protection.

CONCLUSION

For the foregoing reasons, *amicus curiae* Haines and Company, Inc., respectfully submits that this Court should hold that the Copyright Act protects only against the use of the original selection, arrangement and coordination used by the author of a telephone directory and that underlying facts cannot be protected against subsequent use merely because they appear in a copyrighted directory.

Respectfully submitted,

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